REMARKS

Claims 1-48 remain pending in this application.

In the Office Action mailed January 17, 2006, Claims 1-48 are rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,846,850 issued to Schilling et al., and U.S. Pat. No. 6,423,759 issued to Schilling et al., each taken individually. Claims 1-48 are rejected under 35 U.S.C. §102(a), as being anticipated by WO 03/089,505 in the name of Doerge et al. Claims 1-48 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,688,833 issued to Lund et al. Claims 1, 3-8, 25 and 27-48 are rejected under 35 U.S.C. §103(a) as being unpatentable over EP 0,822,171 in the name of Tsuchiya et al. Claims 1-48 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,846,850 issued to Schilling et al., and U.S. Pat. No. 6,423,759 issued to Schilling et al., each taken individually. Claims 1-48 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-2 of U.S. Pat. No. 6,846,850 issued to Schilling et al. and Claims 1-14 of U.S. Pat. No. 6,562,880 issued to Doerge et al. each taken individually. Claims 1-48 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1, 2, 5, 8 and 11-13 of copending application Serial No. 10/894,692, over Claims 1-9 of copending application Serial No. 10/965,349, over Claims 1-24 of copending application Serial No. 10/281,733 and over Claims 1-8 of copending application Serial No. 10/295,315, each taken individually.

Rejections under 35 U.S.C. §102(e) as anticipated by Schilling et al. '850

Claims 1-48 stand rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,846,850 issued to Schilling et al. Applicants respectfully disagree with the Examiner's contention regarding Schilling et al.

In the Declaration submitted October 18, 2005 in the instant application, Mr. Doerge, one of the named inventors of the instant application, states that he was an inventor of the relevant material disclosed, but not claimed in U.S. Pat. No. 6,846,850, thus showing it to be not "by another" as defined under the statute. As the Examiner is well aware, only those people who made some contribution to the

subject matter of at least one claim are named as inventors of a United States patent. As Mr. Doerge did not contribute to the subject matter of at least one of the claims of U.S. Pat. No. 6,846,850, he was not named as an inventor thereof. If the Examiner continues to deem Mr. Doerge's Declaration insufficient, Applicants respectfully request his guidance as to what the Examiner will accept as proof of what was Mr. Doerge's own work. Failing that, Applicants respectfully request the Examiner reconsider and reverse his rejection of Claims 1-48 under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,846,850 issued to Schilling et al.

Rejections under 35 U.S.C. §102(e) as anticipated by Schilling et al. '759

Claims 1-48 stand rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,423,759 issued to Schilling et al. Applicants respectfully disagree with the Examiner's contention regarding Schilling et al.

Applicants herewith file a declaration under 37 CFR 1.132 stating that any relevant material disclosed but not claimed in U.S. Pat. No. 6,423,759 was derived from an inventor of the instant application and thus can not be considered the invention by "another" within the meaning of 35 U.S.C. §102(e).

Therefore, Applicants respectfully request the Examiner reconsider and reverse his rejection of Claims 1-48 under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,423,759 issued to Schilling et al.

Rejections under 35 U.S.C. §102(a) as anticipated by Doerge et al.

Claims 1-48 stand rejected under 35 U.S.C. §102(a), as being anticipated by WO 03/089,505 in the name of Doerge et al. Applicants respectfully disagree with the Examiner's contention regarding Doerge et al. According to 35 U.S.C. §102(a), "a person shall be entitled to a patent unless, the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, ..."

Applicants wish to draw the Examiner's attention to the fact that WO 03/089,505 claims priority to U.S. Serial No. 10/124,567 filed April 17, 2002. U.S. Serial No. 10/124,567 matured into U.S. Pat. No. 6,562,880. As the Examiner states at page 3 of the instant Office Action that,

> (r)ejection over Doerge et al. (6,562,880) is withdrawn in light of applicants' affidavit showing that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another"

Applicants fail to appreciate how the invention the Examiner has stated in the instant Office Action to have been demonstrated to not be an invention "by another" metamorphoses into such upon filing the identical application with the World Intellectual Property Organization ("WIPO").

Therefore, Applicants respectfully request the Examiner reconsider and reverse his rejection of Claims 1-48 under 35 U.S.C. §102(a), as being anticipated by WO 03/089,505 (equivalent to U.S. Pat. No. 6,562,880) in the name of Doerge et al.

Rejections under 35 U.S.C. §103(a) as obvious over Lund et al.

Claims 1-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,688,833 issued to Lund et al. Applicants respectfully disagree with the Examiner's contention regarding Lund et al.

The Examiner states at page 6 of the instant Office Action that, "Lund et al. differs from Applicants' claims in that it does not particularly recite specific ranges of amount values for its blends of polyol components." The Examiner goes on to state, also at page 6, that, "Lund et al. differs from Applicants' claims in that the amounts of HFC-245fa employed are not particularly limited to the ranges of values set forth by Applicants' claims."

Although Applicants agree with the Examiner's assessment that the teaching of Lund et al. differs from the instant claims, they contend that it differs to a far greater degree than suggested by the Examiner. As described at col. 1, lines 7-9, the invention of Lund et al. is an azeotropic-like mixture of blowing agents containing 1,1,1,3,3-pentafluoropropane (HFC-245fa) and 1,1-dichloro-1-fluoroethane. In contradistinction, Applicants teach (at page 8, lines 9-12 of the instant specification) and claim foams blown solely with 1,1,1,3,3-pentafluoropropane (HFC-245fa); not in an azeotropic mixture or in an azeotropic-like mixture as in Lund et al. Thus, Lund et al. neither teach nor suggest the instantly claimed invention.

Therefore, Applicants contend that nothing in the teaching of Lund et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse his rejection of Claims 1-48 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,688,833 issued to Lund et al.

Rejections under 35 U.S.C. §103(a) as obvious over Tsuchiya et al.

Claims 1, 3-8, 25 and 27-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over EP 0,822,171 in the name of Tsuchiya et al. Applicants respectfully disagree with the Examiner's contention regarding Tsuchiya et al.

Tsuchiya et al. in examples 20-38 disclose preparations of polyurethane foams produced from an o-tolylenediamine-based polyether polyol (see page 6, line 29). Further, Tsuchiya et al. do not provide any physical properties of their foams, such as k-factors. Tsuchiya et al. fail to teach or suggest the instantly claimed blend of polyols.

Therefore, Applicants contend that nothing in the teaching of Tsuchiya et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse his rejection of Claims 1, 3-8, 25 and 27-48 under 35 U.S.C. §103(a) as being unpatentable over EP 0,822,171 in the name of Tsuchiya et al.

Rejections under 35 U.S.C. §103(a) as obvious over Schilling et al. '850

Claims 1-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,846,850 issued to Schilling et al. Applicants respectfully disagree with the Examiner's contention regarding Schilling et al. At the paragraph spanning pages 8 and 9, the Examiner states,

> The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; ....

Applicants believe that they have demonstrated the claimed invention is not "by another" as defined in the statute by the Declaration of Mr. Doerge submitted October 18, 2005 and respectfully request the Examiner reconsider and reverse his rejection of Claims 1-48 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,846,850 issued to Schilling et al.

Rejections under 35 U.S.C. §103(a) as obvious over Schilling et al. '759

Claims 1-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,423,759 issued to Schilling et al. Applicants respectfully disagree with the Examiner's contention regarding Schilling et al. At the paragraph spanning pages 8 and 9, the Examiner states,

> The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; ....

Applicants herewith file a declaration under 37 CFR 1.132 stating that any invention disclosed but not claimed in U.S. Pat. No. 6,423,759 was derived from an inventor of the instant application and thus can not be considered the invention by "another" within the meaning of the statute.

Therefore, Applicants respectfully request the Examiner reconsider and reverse his rejection of Claims 1-48 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,423,759 issued to Schilling et al.

Rejections under judicially created doctrine of obviousness-type double patenting over Schilling et al. '850

Claims 1-48 stand rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-2 of U.S. Pat. No. 6,846,850 issued to Schilling et al. At page 10 of the instant Office Action, the Examiner states,

> Claims 1-48 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,846,850 and claims 1-14 of U.S. Patent No. 6,562,880, each taken individually.
>
> And further at page 11, that,
>
> Rejections are maintained because the Terminal Disclaimers referred to are not of record. Applicants need to resubmit copies of the previously submitted Terminal Disclaimer or, in the unlikely event they were not already submitted, submit them now.

Applicants submit herewith a copy of the Terminal Disclaimer previously filed in this application over Schilling et al. '850. Applicants also submit a copy of the return postcard date stamped October 21, 2005 evidencing that three (3) Terminal Disclaimers (for U.S. Pat. No. 6,846,850; U.S. Pat. No. 6,562,880; and U.S. Pat. No. 6,423,759) were received by the USPTO. Finally, Applicants submit a record of Applicants' Attorneys' deposit account for October 2005 showing that fees for three (3) Terminal Disclaimers were charged thereto for the instant application on October 24, 2005.

Applicants respectfully request that the previously submitted Terminal Disclaimer over Schilling et al. '850 be entered, that no additional charges be assessed and that the Examiner remove his rejection of Claims 1-48 under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-2 of U.S. Pat. No. 6,846,850 issued to Schilling et al.

Rejections under judicially created doctrine of obviousness-type double patenting over Doerge et al. '880

Claims 1-48 stand rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-14 of U.S. Pat. No. 6,562,880 issued to Doerge et al. At page 10 of the instant Office Action, the Examiner states,

> Claims 1-48 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,846,850 and claims 1-14 of U.S. Patent No. 6,562,880, each taken individually.
>
> And further at page 11, that,

> Rejections are maintained because the Terminal Disclaimers referred to are not of record. Applicants need to resubmit copies of the previously submitted Terminal Disclaimer or, in the unlikely event they were not already submitted, submit them now.

Applicants submit herewith a copy of the Terminal Disclaimer previously filed in this application over Doerge et al. '880. Applicants also submit a copy of the return postcard date stamped October 21, 2005 evidencing that three (3) Terminal Disclaimers (for U.S. Pat. No. 6,846,850; U.S. Pat. No. 6,562,880; and U.S. Pat. No. 6,423,759) were received by the USPTO. Finally, Applicants submit a record of Applicants' Attorneys' deposit account for October 2005 showing that fees for three (3) Terminal Disclaimers were charged thereto for the instant application on October 24, 2005.

Applicants respectfully request that the previously submitted Terminal Disclaimer over Doerge et al. '880 be entered, that no additional charges be assessed and that the Examiner remove his rejection of Claims 1-48 under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-14 of U.S. Pat. No. 6,562,880 issued to Doerge et al.

Provisional rejections under judicially created doctrine of obviousness-type double patenting over US Serial No. 10/894,692

Claims 1-48 stand provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1, 2, 5, 8 and 11-13 of copending application Serial No. 10/894,692.

Applicants respectfully disagree with the Examiner's contention regarding copending application Serial No. 10/894,692. However, in the interests of expediting prosecution of the instant application, Applicants herewith offer to file a Terminal Disclaimer disclaiming that portion of the term of any patent granted in the instant application which would exceed that of copending application Serial No. 10/894,692.

Provisional rejections under judicially created doctrine of obviousness-type double patenting over US Serial No. 10/965,349

Claims 1-48 stand provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-9 of copending application Serial No. 10/965,349.

Applicants respectfully disagree with the Examiner's contention regarding copending application Serial No. 10/965,349. However, in the interests of expediting prosecution of the instant application, Applicants herewith offer to file a terminal disclaimer disclaiming that portion of the term of any patent granted in the instant application which would exceed that of copending application Serial No. 10/965,349.

Provisional rejections under judicially created doctrine of obviousness-type double patenting over US Serial No. 10/281,733

Claims 1-48 stand provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-24 of copending application Serial No. 10/281,733.

Applicants respectfully disagree with the Examiner's contention regarding copending application Serial No. 10/281,733 and note that that application has been abandoned for failure to respond to the adverse decision by the Board of Patent Appeals & Interferences ("BPAI") mailed March 28, 2006 thus precluding any possibility of double patenting vis-à-vis application Serial No. 10/281,733.

Provisional rejections under judicially created doctrine of obviousness-type double patenting over US Serial No. 10/295,315

Claims 1-48 stand provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-8 of copending application Serial No. 10/295,315.

Applicants respectfully disagree with the Examiner's contention regarding copending application Serial No. 10/295,315. However, in the interests of expediting prosecution of the instant application, Applicants herewith offer to file a terminal disclaimer disclaiming that portion of the term of any patent granted in the instant application which would exceed that of copending application Serial No. 10/295,315.

CONCLUSION

Applicants have made no claim amendments because they submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-48. If the Examiner is of the opinion that the instant application is in condition for other than allowance, he is invited to contact the Applicants' Attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

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